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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/542,536

07/18/2005

Donna Hui-Ing Hwang

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05/13/2008

AKERMAN SENTERFITT

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EXAMINER

SOROUGH, LAYLA

ART UNIT

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1617

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/542,536	<b>Applicant(s)</b> HWANG ET AL.	
	<b>Examiner</b> LAYLA SOROUGH	<b>Art Unit</b> 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 10 and 12-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10 and 12-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/18/06</u> .  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

The response filed February 12, 2008 presents remarks and arguments submitted to the office action mailed October 2, 2007 is acknowledged.

Applicant's arguments over the 35 U.S.C. 112 second paragraph rejection of claims 10-19 is not persuasive. Therefore, the rejection is maintained for reasons of record.

Applicant's arguments over the 35 U.S.C. 103(a) rejection of claims 10-16 over Sonne Mackles ( WO 86/05389 – IDS) view of Hatfield (US Pat. No. 4,708,812) and Bergmann et al. (6,274,128) is not persuasive. Therefore, the rejection is maintained for reasons of record.

Applicant's arguments over the 35 U.S.C. 103(a) rejection of claims 17-19 over Sonne Mackles ( WO 86/05389 – IDS) view of Hatfield (US Pat. No. 4,708,812) and Bergmann et al. (6,274,128) as applied to claims 10-16, and further in view of Mackles et al. (US Pat. No. 5,322,683 ) is not persuasive. Therefore, the rejection is maintained for reasons of record.

For Applicants convenience, the rejections of record are restated below:

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10-19 are rejected under 35 U.S.C. 112, second paragraph, as being

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indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term a cosmetically useful castor oil "derivative," is rendered indefinite. One of ordinary skill in the art could not ascertain and interpret the metes and bounds of the patent protection desired as claimed in this case, since one of ordinary skill in the art would clearly recognize that many various groups could possibly be substituted in each instance. As a result, any significant variation would be reasonably expected to alter the compound, e.g. physical, chemical, physiological effects and functions.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mackles ( WO 86/05389 – IDS (previously presented)) view of Hatfield (US Pat. No. 4,708,812(previously presented)) and Bergmann et al. (6,274,128(previously presented)).

Mackles teaches an anhydrous cosmetic for the hair and scalp comprising 10 – 50% activated zeolites of aluminosilicate. The ratio of Si to Al is 1.1 to 0.1 (see claim 5). The composition further contains liquid oils such as triglycerides, a foaming component, and a propellant. Non-ionic surface-active agents are in the form of sorbitan

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stearates, PEG-400 dioleates or lecithin and are used in 3 – 15 wt % of the composition (claim 21). The softeners used are glycerol stearates, silicone oils or isobutyl isobutyrate. Cabosil M-5 is used as a thickening agent. The addition of polyvalent alcohols is not disclosed, nor do any of the examples contain polyvalent alcohols. The composition heats up upon contact with moist hair (see for example page 14).

The combination of water relative to the weight of the product and temperature increase of the method claims is clearly envisaged by the teachings of the prior art. The prior art clearly teaches the composition heats up upon contact with moist hair.

The reference fails to teach the specific thickeners “polyethylene, 12-hydroxystearic acid, clay, castor oil derivatives or waxes” as claimed in the present claims.

Hatfield is solely incorporated to show that thickeners are inclusive of clays and Cabosil M-5.

Bergmann et al. teaches a self-warming hair conditioning composition which includes kaolin (clay) which are useful as fillers (col 6, lines 62-65). Conditioners of the composition are hydrocarbons inclusive of caprylic/Capric triglyceride and wax (col 4, lines 50-67 and col 5, lines 1-5).

To a person with ordinary skill in the art at the time the invention was made the substitution of clays for Cabosil M-5 is obvious because both compounds are thickeners taught to be interchangeable. The motivation to use clays such as kaolin is because (1) both have similar compositions with similar efficacies (2) Bergmann et al. teaches the compositions used in a similar self-warming hair conditioner, and, therefore, the

interchangeable use of either one will successfully yield similar results.

Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mackles ( WO 86/05389 – IDS(previously presented)) view of Hatfield (US Pat. No. 4,708,812(previously presented)) and Bergmann et al. (6,274,128(previously presented)), as applied to claims 10-16, and further in view of Mackles et al. (US Pat. No. 5,322,683 (previously presented)).

The Mackles ( WO 86/05389 – IDS), Hatfield (US Pat. No. 4,708,812) and Bergmann reference do not specifically teach the method of cleansing as claimed.

Mackles ('683) teaches a self-heating foam composition comprising aluminosilicates useful as a hair conditioner and facial cleanser.

To a person with ordinary skill in the art at the time the invention was made it would be obvious to modify the self-heating foam composition to provide a facial cleansing composition. The motivation to make such a modification is because (1) both have similar compositions with similar self-heating foam properties, and, therefore, the interchangeable use of either one will successfully yield similar results.

### ***Response to Arguments***

Applicant's arguments filed on February 12, 2008 have been considered but are not fully persuasive.

In response to Applicant's argument that a person of skill in the art would quickly understand which castor oil derivatives are cosmetically useful is not persuasive.

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Examiner respectfully reiterates "the term a cosmetically useful castor oil "derivative," is rendered indefinite. One of ordinary skill in the art could not ascertain and interpret the metes and bounds of the patent protection desired as claimed in this case, since one of ordinary skill in the art would clearly recognize that many various groups could possibly be substituted in each instance. As a result, any significant variation would be reasonably expected to alter the compound, e.g. physical, chemical, physiological effects and functions."

Applicant argues "Mackles WO acknowledges cosmetic products containing such particulate solids have not been successfully marketed because they are "very oily, greasy, and pasty in consistency; spread poorly on the skin, and leave the skin with a greasy feel and appearance," see Mackles WO, page 1, ln. 21-24. Mackles WO discloses that it solves this problem by utilizing a stable foam produced from an oil and a propellant, see Mackles WO, page 3, ln. 2-17. However, Mackles WO does not disclose or suggest a method of overcoming the above-described deficiencies without utilizing an aerosol foam that contains a propellant." Applicant argues limitations that are not claimed; therefore, the arguments are not persuasive.

Further, the argument that "Mackles WO provides for zeolites that contain up to 5 wt-% water, see Mackles WO, page 9, lines 25-26," whereas "the claimed cosmetic products include zeolites that contain "no polyvalent alcohols and polar solvents," such as water, see claims 1 & 17," is not persuasive. The reference recites "These zeolites are preferably in the activated form which effectively means that they have been pretreated in such a manner that they contain not in excess of 5% by weight of water."

Hence, the teaching of the prior art reads on the zeolites containing 0% by weight of water. Therefore, the teaching of Mackles meets the claimed limitation.

Applicant's arguments regarding the Bergmann reference is not persuasive. Bergmann was solely incorporated to show that self-warming compositions can include kaolin (clay) which is useful as a filler (col 6, lines 62-65), caprylic/Capric triglyceride and wax (col 4, lines 50-67 and col 5, lines 1-5). Additionally, Applicant's argument regarding the Hatfield reference is not persuasive. The Hatfield reference is solely used to show that clays and Cabosil M-5 have the same property, that is, they are both thickeners. The Mackles and Bergmann references are used to show that these compounds are both useful in cosmetic compositions. Moreover, these compounds are both widely used in the cosmetic arts.

Applicant submits that the zeolite containing composition produced by the rejection is not capable of producing the claimed level of heating, as recited in claims 17-19. Applicant's 132 Declaration has been considered but is not persuasive. The Declaration does not commensurate in scope because the comparison has not been made with respect to the prior art relied upon. Unless comparison is made with disclosure identical (not similar) with that of the reference, affidavits or declarations comparing applicant's results with those of the prior art have no probative value.

The arguments are not persuasive and the rejection is made **FINAL**.

Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Conclusion***

No Claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Layla Soroush whose telephone number is (571)272-5008. The examiner can normally be reached on Monday through Friday from 8:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/SREENI PADMANABHAN/

Supervisory Patent Examiner, Art Unit 1617